

DAC / 2133
2700
#11
PATENT

In re Application of

Shigeki OHBAYASHI

Serial No.: 09/196,136

Group Art Unit: 2133

RECEIVED

JUN 23 2003

Filed: November 20, 1998

Examiner: Guy Lamarre Technology Center 2100

For: SEMICONDUCTOR INTEGRATED CIRCUIT HAVING BONDING
OPTIONAL FUNCTION

PETITION FOR REVIEW OF THE DIRECTOR'S DECISION UNDER 37 CFR
1.181(a)(3) REGARDING REQUEST TO WITHDRAW HOLDING OF
ABANDONMENT

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JUN 23 2003

Technology Center 2600

Sir:

Noting the Decision on Petition mailed May 19, 2003, wherein the Request for Reconsideration filed September 9, 2002 is DISMISSED, applicants respectfully further request reconsideration for the following reasons:

(1) The Decision indicates that there is no provision for filing a request for change of correspondence address by email. The undersigned hereby submits that there is no provision prohibiting the filing of the change of address appropriately by email. It is noted that upon the undersigned's office's inquiry to the USPTO in June, 2000 on how to effect an electronic change of address by customer number, the office was advised by Terry Downey that submission by email was acceptable (Exhibit A). From August 25, 2000 through October 24, 2000, by multiple email communications with Ms. Downey

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JUL 21 2003

OFFICE OF PETITIONS

and Tina Fuller of the USPTO Electronic Business Center, the Change of Address by customer number was submitted, acknowledged, reviewed and corrected (Exhibit B). A copy of the USPTO Correspondence Address Database showing that the change of address for the undersigned's customer number was in fact modified by Ms. Fuller on October 12, 2000 and a confirmation of the list of applications indicating the change entered into the USPTO records (a partial copy provided herewith) is attached as Exhibit C.

2) The decision indicates that applicant's submission provides evidence that the Office Action was not received at the firm's Washington DC address, did not provide evidence of non-receipt with respect to the address of record and did not show non-receipt for the January 19, 2001 Official Action. It is respectfully submitted that in view of 1) above, applicants have provided evidence that the address of record was the Washington DC address, and the evidence provided in the Request filed September 9, 2002 adequately establish proof of non-receipt of the Official Action dated January 19, 2001 (a copy of the automated docket and Docket Book page for the due date of April 19, 2001 is resubmitted herewith in Exhibit D).

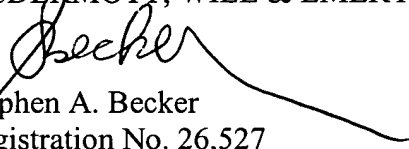
3) It is further submitted that the Notice of Abandonment is based on the August 16, 2001 Office Action (not the January 19, 2001 office action). In this regard, it is respectfully submitted that the evidence provided in the Request filed May 6, 2002 adequately establish proof of non-receipt of the Official Action dated August 16, 2001, despite a Correspondence Address Change filed July 24, 2001 pursuant to the Examiner's request (a copy of the automated docket and Docket Book page for the due date of November 16, 2001 is resubmitted herewith in Exhibit E).

In view of the foregoing, it is respectfully submitted that the undersigned took proper steps for recording change of address with the USPTO, that such change of address was recorded by the USPTO, and has provided adequate evidence to established that an error in mailing occurred on the part of the USPTO for both the January 19, 2001 Official Action and its remailing on August 16, 2001. Accordingly, rescind of the abandonment, return to pending status of the application and remailing of the Action with reset date and believed to be in order and respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY


Stephen A. Becker
Registration No. 26,527

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SAB:cms
Facsimile: (202) 756-8087
Date: June 19, 2003

6/27/00

Terry Downey happily ok -

Free people do have credit

Credit

trying to get in one location

transmit letter or doc?

e mail Excel format
now

new thing

Downey
@usps.gov

they run through an
address file

upper
case

if we want it to

be our address

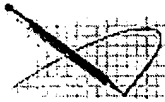
as well as our purpattg

put on
both if we
want everythg
to go there

if we don't want all can
turn - don't put on turn on

labels

Tara Fuller 305-3028 more



Deanna Dick

08/25/00 04:07 PM

To: tdowney@uspto.gov

cc:

Subject: Items to add to our customer number

Here is our Excel document regardin cases that should be associated with our Customer Number 20277. Please let me know if we prepared this properly and if we need to provide anything else.

Thank you.



- WDC99_308172_1.XLS

Deanna Dick

IP Administrator

McDermott, Will & Emery

202-756-8308

ddick@mwe.com

This message is a PRIVATE communication. If you are not the intended recipient, please do not read, copy, or use it, and do not disclose it to others. Please notify the sender of the delivery error by replying to this message, and then delete it from your system. Thank you.



Tina.Fuller@USPTO.G
OV

08/28/00 07:28 AM

To: Deanna Dick/DC/MW&E@MW&E
cc:
Subject: FW: Items to add to our customer number

Hi Deanna,

Terry forwarded your spreadsheet to me for processing and there is a problem with the formatting. I have attached a copy of a template spreadsheet that you can use with all of the formatting already done. Most importantly, please remove all of the "/" and "," from the serial numbers and patent numbers. Also, the date should be in 00/00/00 format. Lastly, we cannot use your Client/Matter numbers, so you can remove those columns. Please email your spreadsheet directly to me once it's done, thanks!

<<cust_req_instructions_new.xls>>

Tina Fuller
USPTO
Patent Electronic Business Center
Voice: (703) 308-6130
Fax: (703) 308-2840
tina.fuller@uspto.gov

> -----Original Message-----

> From: Downey, Terry
> Sent: Friday, August 25, 2000 5:02 PM
> To: Fuller, Tina (Troy System)
> Subject: FW: Items to add to our customer number

>
>
>

> -----Original Message-----

> From: ddick@mwe.com [SMTP:ddick@mwe.com]
> Sent: Friday, August 25, 2000 4:07 PM
> To: tdowney@uspto.gov
> Subject: Items to add to our customer number

>
>
>

> Here is our Excel document regardin cases that should be associated with
> our

> Customer Number 20277. Please let me know if we prepared this properly
> and if

> we need to provide anything else.

>

> Thank you.

>

> (See attached file: WDC99_308172_1.XLS)

> Deanna Dick

> IP Administrator

> McDermott, Will & Emery

> 202-756-8308

> ddick@mwe.com

>

>

> *****

> *****

>

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> recipient, please do not read, copy, or use it, and do not disclose it to

> others. Please notify the sender of the delivery error by replying to

> this

> message, and then delete it from your system. Thank you.

> *****

> ***** <<Microsoft Excel 97>>



- cust_req_instructions_new.xls



- WDC99_308172_1.XLS



Deanna Dick

08/29/00 06:25 PM

To: tina.fuller@uspto.gov

cc:

Subject: 020277

Thank you so much for the rapid response! Okay; here goes again!

Deanna Dick

McDermott, Will & Emery

202-756-8308



- WDC99_308172_1.XLS

This message is a PRIVATE communication. If you are not the intended recipient, please do not read, copy, or use it, and do not disclose it to others. Please notify the sender of the delivery error by replying to this message, and then delete it from your system. Thank you.



Deanna Dick

09/25/00 04:28 PM

To: tina.fuller@uspto.gov

cc:

Subject: 020277

Just wanted to make sure you received the e-mailed doc. below last month; I know you may not be ready with a listing yet; but just wanted to make sure you have received so that it's in progress. Thanks!

Deanna Dick
McDermott, Will & Emery
202-756-8308

----- Forwarded by Deanna Dick/DC/MW&E on 09/25/2000 04:26 PM -----



Deanna Dick

08/29/2000 06:25 PM

To: tina.fuller@uspto.gov

cc:

Subject: 020277

Thank you so much for the rapid response! Okay; here goes again!

Deanna Dick
McDermott, Will & Emery
202-756-8308



- WDC99_308172_1.XLS

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Tina.Fuller@USPTO.G

OV

09/29/00 12:52 PM

To: Deanna Dick/DC/MW&E@MW&E

cc:

Subject: RE: 020277

Hi Deanna,

I apologize for the delay. I just realized (via your email reminder) that I hadn't gotten your file back from our database people yet. They run it through the database to see if there are any "questionable" files that we would need you to verify, and they haven't gotten that report to me yet. So I sent the file to them again today, so hopefully I will have something shortly to send to you. It doesn't normally take this long, so please accept my apologies.

Thank you for your patience!

Tina Fuller
USPTO
Patent Electronic Business Center
Voice: (703) 308-6130
Fax: (703) 308-2840
tina.fuller@uspto.gov

-----Original Message-----

From: ddick@mwe.com [mailto:ddick@mwe.com]
Sent: Monday, September 25, 2000 4:29 PM
To: tina.fuller@uspto.gov
Subject: 020277

Just wanted to make sure you received the e-mailed doc. below last month; I know

you may not be ready with a listing yet; but just wanted to make sure you have

received so that it's in progress. Thanks!

Deanna Dick
McDermott, Will & Emery
202-756-8308

----- Forwarded by Deanna Dick/DC/MW&E on 09/25/2000 04:26 PM

Deanna Dick
08/29/2000 06:25 PM

To: tina.fuller@uspto.gov
cc:
Subject: 020277

Thank you so much for the rapid response! Okay; here goes again!

Deanna Dick
McDermott, Will & Emery
202-756-8308

(See attached file: WDC99_308172_1.XLS)

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Deanna Dick

09/29/00 01:29 PM

To: Tina.Fuller@USPTO.GOV

cc:

Subject: RE: 020277

Thanks; appreciate your attention to this!

Deanna Dick
McDermott, Will & Emery

Tina.Fuller@USPTO.GOV on 09/29/2000 12:52:34 PM



Tina.Fuller@USPTO.GOV on 09/29/2000 12:52:34 PM

To: Deanna Dick/DC/MW&E@MW&E

cc:

Subject: RE: 020277

t:

Hi Deanna,

I apologize for the delay. I just realized (via your email reminder) that I hadn't gotten your file back from our database people yet. They run it through the database to see if there are any "questionable" files that we would need you to verify, and they haven't gotten that report to me yet. So I sent the file to them again today, so hopefully I will have something shortly to send to you. It doesn't normally take this long, so please accept my apologies.

Thank you for your patience!

Tina Fuller
USPTO
Patent Electronic Business Center
Voice: (703) 308-6130

Fax: (703) 308-2840
tina.fuller@uspto.gov

-----Original Message-----

From: ddick@mwe.com [mailto:ddick@mwe.com]
Sent: Monday, September 25, 2000 4:29 PM
To: tina.fuller@uspto.gov
Subject: 020277

Just wanted to make sure you received the e-mailed doc. below last month; I know you may not be ready with a listing yet; but just wanted to make sure you have received so that it's in progress. Thanks!

Deanna Dick
McDermott, Will & Emery
202-756-8308

----- Forwarded by Deanna Dick/DC/MW&E on 09/25/2000 04:26 PM

Deanna Dick
08/29/2000 06:25 PM

To: tina.fuller@uspto.gov
cc:
Subject: 020277

Thank you,so much for the rapid response! Okay; here goes again!

Deanna Dick
McDermott, Will & Emery
202-756-8308

(See attached file: WDC99_308172_1.XLS)

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Tina.Fuller@USPTO.G
OV

10/03/00 07:25 AM

To: Deanna Dick/DC/MW&E@MW&E
cc:

Subject: Excel Spreadsheet Error Files for Customer # 20277

Hi,

I have received your spreadsheet to associate your applications/patents with your customer number, and there are just a few more questions. There are a few files that are currently going to a different address for correspondence and we just have to do a little preventative maintenance to be absolutely sure that you do, in fact, want to update these files to your customer number.

Please take a look at the attached spreadsheet, which lists the "questionable" applications. Once you have verified whether or not you wish to associate these applications/patents with your customer number, please mark them as such on the attached spreadsheet (i.e., yes/no) and email it back to me, or simply email me the list of applications/patents that you DO NOT wish to be associated with your customer number. Please DO NOT delete any applications from the spreadsheet.

If there are NO changes to be made, you can just email me back to let me know that it is ok to associated all files with your customer number.

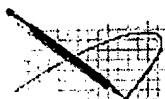
If you have any questions, please feel free to contact me.

<<20277cusno_error.xls>>

Tina Fuller
USPTO
Patent Electronic Business Center
Voice: (703) 308-6130
Fax: (703) 308-2840
tina.fuller@uspto.gov



- 20277cusno_error.xls



Deanna Dick

10/24/00 02:33 PM

To: tina.fuller@uspto.gov

cc:

Subject: 020277

Tina - , I have now finally completed the review of the 'error list' you sent to me regarding our customer number 020277.

Further to our telephone conversation a couple of weeks ago, I have attached an Excel spreadsheet which includes only those applications which were on the error list and which **SHOULD** be associated with our customer number. (There were in fact several that were properly being associated with other addresses which I have not included here).

[As you may remember, you asked that I submit it this way because you kindly went ahead and updated the ones that were ok].

Of course if you have any questions, just e-mail or call.

Thank you so much; you're always a pleasure to work with.



- WDC99_337147_1.XLS

This message is a **PRIVATE** communication. If you are not the intended recipient, please do not read, copy, or use it, and do not disclose it to others. Please notify the sender of the delivery error by replying to this message, and then delete it from your system. Thank you.

For more information on **McDERMOTT, WILL & EMERY** please visit our website at:

<http://www.mwe.com/>

Correspondence Address

Customer Number

20277

Change Reason *

Directly Supplied

Name *

MCDERMOTT WILL & EMERY

Save

Street *

600 13TH STREET, N.W.

Refresh

City *

WASHINGTON

Clear

State/Province

BC

...

Postal

20005-3096

Country *

US

...

Other Contact Information:

Phone No. / Ext.

202-756-8000

Fax No.

202-756-8087

E-Mail

Print

Cancel

Last Modification

TFULLER

10/12/2000

vjones1

02/21/2002

PMCSBIC APC Application Correspondence Address Misto...				
File Edit Window Help				
Begin Date	End Date	Change Reason Code	Customer No	Address
03/20/2001			20277	MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON 20005-3
10/12/2000			20277	FAX202-756-8087
10/12/2000			20277	TEL202-756-8000
10/12/2000	03/19/2001	CREQ	20277	MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, 20005-3
01/12/1999	10/12/2000			MCDERMOTT WILL & EMERY SUITE 300 99 CANAL CENTER PLAZA ALEXANDR

02/21/2002

[illegible]

Country Application

09-Sep-02

Client-Matter:	049657-0217	Country:	US	SubCase:	021
Family Number:	049657-0217		United States of America		
Case Type:	PRI	Application Status:	Pending		
Application Number:	09/196,136	Filing Date:	20-Nov-1998		
Patent Number:		Issue Date:			
Publication Number:		Publication Date:			
Priority Number:	10-168311	Priority Date:	16-Jun-1998		
Tax Schedule:	LE	Expiration Date:			
Reel & Frame:		Tax Start Date:			
Group Art Unit:	2812	ClientRef:	998140-01		
Agent:					
Agent Reference Number:					

List Of User Actions

Action(s) Due	Due Date	Action Taken
REQ FOR RECONSIDERATION	09-Sep-2002	Final

Remarks: UTIL APP W/F DRWGS, IDS, PRIOR, CPD, ASSIGN F. 11/20/98;
CORRESPONDENCE ADDRESS CHANGE F. 7/24/01 (VIA FAX TO
EXAMINER) -- N/ABANDONMENT RECD 04/24/02 -- REQ TO
WITHDRAW HOLDING OF ABAND F. 05/06/02; DEC ON PET,
DISMISSED, DTD 7/9/02 RECD 7/15/02

User ID: myeholt

Date Created: 15-Nov-1999

Last Update: 16-Jul-2002

~~X 50034-040⁷⁵~~~~R (w)~~~~cut~~~~Not Chw~~~~49657-654~~~~R (w)~~~~1st 4/3~~~~f 4/10~~~~AVY~~~~49657-557~~~~R (w)~~~~1st 3/28~~~~f 4/3~~~~LOC AVY~~~~49657-528~~~~R (w)~~~~1st 3/28~~~~f 4/5~~~~LOC AVY~~~~X 50461-022~~~~R (w)~~~~cut~~~~BFC~~

②

~~50469-051~~~~R (w)~~~~1st 4/9~~~~f~~~~Chw
SHE-SAS~~~~49921-062~~~~R (w)~~~~cut~~~~LOC SAS~~~~50032-140~~~~R (w)~~~~cut~~~~LOC SAS~~~~49657-589~~~~Rest Rep (w)~~~~1st 4/10~~~~f~~~~SAS~~~~50090-135~~~~Rest R (w)~~~~1st 4/10~~~~f~~~~SAS~~

Country Application

02-May-02

Client-Matter:	049657-0217	Country:	US	SubCase:	021
Family Number:	049657-0217		United States of America		
Case Type:	PRI	Application Status:	Pending		
Application Number:	09/196,136	Filing Date:	20-Nov-1998		
Patent Number:		Issue Date:			
Publication Number:		Publication Date:			
Priority Number:	10-168311	Priority Date:	16-Jun-1998		
Tax Schedule:	LE	Expiration Date:			
Reel & Frame:		Tax Start Date:			
Group Art Unit:	2812	ClientRef:	998140-01		
Agent:					
Agent Reference Number:					

List Of User Actions

Action(s) Due	Due Date	Action Taken
REPLY TO NOT. OF ABAND.	07-May-2002	Final
Office Action Received Yet?	27-Jun-2002	Due Date

Remarks: UTIL APP W/F DRWGS, IDS, PRIOR, CPD, ASSIGN F. 11/20/98;
CORRESPONDENCE ADDRESS CHANGE F. 7/24/01 (VIA FAX TO
EXAMINER) -- N/ABANDONMENT RECD 04/24/02

User ID: BARTIS **Date Created:** 15-Nov-1999 **Last Update:** 30-Apr-2002

NOVEMBER

16

FRIDAY

J1 320th day - 45 days follow

X 49657-565 OA Response Due 11/9 AC
SAB

50036-013 OA Response Due 11/23 10/25 RF
~~SAB~~ ~~SAB~~

49657-785 IF Due 11/5 11/8 N/A

50573-018 OA Response Due 11/30 11/5 AC
SAB

10473-159 OA Response Due int 4/10/5 NC

~~49657-899~~

57454-273 DIV of 49657-399 11/9 App

57454-286 Cont of 49657-130 11/14 App

~~49657-200~~

X 10473-824 MicroVAR product clearance 11/23 NC
DIP 5004919

X 49657-657 formal comm for Ex to cur down N/A

50036-302 sel cost New invoice due 11/9 App

X 49657-670 price PTO 90c part → N/A

X 10473-823 Ed new inf opinion of USO 6/4/85 11/23 NC